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10/659,854	09/10/2003	Dong Kyu Lee	2060-3-58	5037
35884 7590 12/14/2009 LEE, HONG, DEGERMAN, KANG & WAIMEY 660 S. FIGUEROA STREET Suite 2300 LOS ANGELES, CA 90017				
EXAMINER AL AUBAIDI, RASHA S				
ART UNIT		PAPER NUMBER		
2614				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/659,854

Applicant(s)

LEE, DONG KYU

Examiner

RASHA S. AL AUBAIDI

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This in response to amendment filed 08/18/2009. No claims have been added. Claims 3, 12 and 21 have been canceled. Claims 1 and 9 have been amended. Claims 1-2, 4-11, and 13-16 are pending in this application.

Claim Rejections - 35 USC § 112

2. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-11 and 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1 and 9 recites "generating ring back tone data independently". However, it is noted that this limitation and precisely the use of "independently" is not taught anywhere in the Applicant's specification. If Applicant's believes that this limitation has a support in the specification Applicant is required to points out to the Examiner where exactly that support is disclosed.

Dependent claims 2, 4-8, 10-11 and 13-16 are rejected for the same reasons as discussed above with respect to independent claims 1 and 9, respectively.

3. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1, recites "generating ring back tone data independently by the first terminal, if the type of the network is a public switched telephone network". However, it is unclear to the Examiner whether the ring back tone **still** is generated by the first terminal **if** the type of network is **not** a public switched telephone network. Clarifications are required.

Claim 1 recites the limitation "the response message" in the "transmitting the response message from the first terminal" and "inserted into the response message" and "wherein the response message is transmitted". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Chung et al. (Pub. No.: 2003/0002476) in view of Son et al. (US PAT # 7,457,278) and further in view of McClary (US PAT # 7,075,951).

Regarding claim 1, Chung teaches in an integrated internet phone call routing system a system and method directed to a call setup procedure for call being placed by phone-to-computer and/or computer-phone [see, 0005-0006, 0011 and 0028]. Chung teaches the use of a gateway that designated to convert and translates protocols when placing calls from/to two different networks (i.e., VOIP and PSTN) [see 0025, 0031]. Chung also discuss that a terminal at a second network (PSTN) may transfer an alert signal (i.e., ring signal) in response to receiving a call connection from another party from the first network [see 0028, lines 64-67 and lines 1-2]. The claimed feature of "identifying a type of a network to which the second terminal requesting the call setup" is obvious if not inherent within the teachings of Chung (see for example, call setup between the two networks 0028).

Although the Examiner believes that the use of "ring back tone" is obvious and well known in the art of telephony. However, Chung does not specifically teach the use of "ring back tone" and does not specifically teach "generating the ring back tone data independently by the first terminal, if the type of the network is a public switched network" as recited in the claim's language.

Thus, the Examiner introduces Son which teaches a terminal connection device , after receiving the response from the VoIP gateway 50b, the IP network 2 transmits to the VoIP gateway 50a an MDCX command indicating that the VoIP gateway 50b calls the telephone terminal 70b (S56a). After receiving the MDCX command, the VoIP gateway 50a transmits to the telephone terminal 70a a **ring back tone** (S56b), and sends to the IP network 2 a response to the MDCX command (S56c) (see col. 14, lines 56-62, col. 15, lines 11-20 and col. 16, lines 19-25). Note that a ring back tone is exchanged between terminals in response to generating call setup request.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of utilizing ring back tone between terminals, as taught by Son, into the teachings of Chung in order to **inform and alert** users of Chung at terminals upon establishing calls. Again, the use and advantages of "ring back tones" are old and well known in the art of telephony. Also, the system or an individual may specify or customize the generation of a ring back tone based on any criteria desired (such as, generating ring back tone if the network is PSTN). This limitation is considered a design choice that does not rise the invention to the level of patentability.

Claims 8-9 and 11 are rejected for the same reasons as discussed above with respect to claim 1. The claimed feature of "decision section for deciding whether to

generate a ring back tone ...etc" as recited in claim 9, is extremely obvious. These kinds of decisions are made in seamless manner that requires no intervention from a user. The claimed "signal processor" as recited in claim 9, is inherent if not obvious. The Examiner reading the limitation of "transmitting the response message from the first terminal to the second terminal in response to the call set up" as the ring back tone that is send from one terminal to another , which is already taught and explained in Son. Also, the claimed limitation of "wherein the response message is transmitted to the port informed by the trunk gateway during the call setup" reads on the sending the ring back tone to the specified port on of the desired destination within the specified network which the Examiner believes it is an obvious limitation within the teachings of Son.

The combination of Chung and Son does not specifically teach" storing the generated ring back tone data in a buffer" and does not specifically teach " wherein the ring back tone is inserted into the response message according to a first-in-first-out method".

However, McClary teaches in a method and apparatus for the operation of a storage unit in a network element a first-in-first-out data registers ("FIFOs") have been used to store and transmit data within portions of network elements (see col. 1, lines 45-58).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of using FIFO, as taught by McClary into the combination of Chung and Son in order to deliver the ring back tone in an FIFO method to the desired destination. Again the use of a FIFO is an old limitation and well known in the art of telephony. Also, one of ordinary skill in the art may choose to store any type of information within a buffer (i.e., ring back tone). Again the Examiner believes that this is a design choice that will not rise the invention to the level of patentability.

Regarding claims 2 and 10, Chung teaches the use of real-time protocol [see 0029].

Regarding claims 4 and 13, Chung teaches providing appropriate voice tuning depending of the type of connection [see 0017].

Claims 5-6 and 14-15 limitation are obvious and well known in the art. One can obviously set any kind of identification parameters such as phone number, prefix, and type of the call, time or the day ...etc. see also discussion of Son col. 7, lines 65-67 and col. 8, lines 1-8.

Regarding claims 7 and 16, this can read on the user going off hook. Obviously when a user goes off hook and answers the call there is no more ring back tone generated.

Response to Arguments

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Regarding Applicant's argument (Page 5 of the Remarks) that recites "Examiner has not acknowledge the Applicant's claim of foreign priority", the Examiner respectfully disagrees and likes to point that the foreign priority is already acknowledged by the Examiner in the first office action (i.e., Non-final) that was issued and mailed to Applicant (**04/09/2007**). All the appropriate boxes were checked already.

Regarding Applicant's argument (Page 5 of the Remarks) that recites "none of the boxes were marked on the Office action Summary page to indicate that the Examiner has accepted the Drawings", the advises the Applicant to look back at the first office action (i.e., Non-final) that was issued and mailed to Applicant (**04/09/2007**). All the appropriate boxes were already checked to indicate acceptance of the drawings.

Regarding Applicant's argument (Page 5 of the Remarks) that recites "Son is improper reference in that is dopes not qualify as a prior art reference in this matter under 35 U.S.C 102. Please note that neither the filing date, the publication date, or the 371(c)(1) date associated with Son predate neither the filing date of the present application not the filing date of the application....etc", the Examiner respectfully

disagrees and likes to point out to Applicant that Son is qualified as a prior art since Son has a foreign priority date that goes back to May 31, 2002, which prior to the foreign priority date of the present application of October 07, 2002.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571)

272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rasha S AL-Aubaidi/

Primary Examiner, Art Unit 2614